

3. "Advanced natural language screening technology"

In claims 11 and 18, the phrase "advanced natural language screening technology" is believed unclear. Reconsideration is requested, because this phrase appears understandable by one of skill in the art. The web-site for WebHire, Inc. says "It uses *advanced natural language screening technology* to filter out non-relevant information, while uncovering the resumes other research tools miss." See PETITION TO MAKE SPECIAL at page 4, line 6-9 (emphasis added) (copy attached). Furthermore, in reviewing the parent '592 patent, the Examiner found statutory the phrase "a rules based technology (such as natural language screening)." Thus, Applicant believes the phrase "advanced natural language screening technology" is clear.

If the Examiner believes the claim term is not clear, however, Applicant respectfully requests the Examiner enter an Examiner's Amendment replacing the phrase "advanced natural language screening technology" with the claim term "a rules based technology (such as natural language screening)," a claim term the Examiner found statutory in the parent '592 patent. Because that amendment is not a narrowing amendment, it does not limit the scope of equivalents. See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. ___ (May 28, 2002).

4. The intended Use of the filter

Regarding claim 1, "No patentable weight is attributed to the intended usage of the filter for searching web pages." In other words, The Patent Office believes the phrase "to identify in said web page the presence or absence of specifically defined professional qualifications" is superfluous language without any legal effect. Applicant respectfully notes that superfluous language without any legal effect may mislead the public regarding the ambit of the claim. Applicant wants the most clear claim possible. Applicant accordingly reserves the right to amend the claim to expressly delete the phrase "to identify in said web page the presence or absence of specifically defined professional qualifications." Applicant will, however, hold this potential formal amendment in abeyance pending resolution of all other questions of patentability.

B. The 102(e) Rejection over Taylor

Claims 1 and 6-19 stand rejected as anticipated under 35 USC 102(e) over Taylor. Reconsideration is requested, because the Patent Office has already reviewed Taylor and found Taylor does not anticipate the invention.

5 1. The Prior Art

The immediate application is a continuation of U.S. Letters Patent 6,381,592. In the parent application, Taylor was of record. See NOTICE OF REFERENCES CITED at Document B (14 Dec. 1999). As explained in the parent case, the prior art includes various data bases where job openings can be listed and where candidates can submit their resumes. This art includes non-
10 computer art such as newspaper and radio help-wanted or help-available classified advertisements. The art also includes computer based things like internet-based job-opening bulletin boards or resume data bases. Examples include McGovern (US 5,978,768) and the various "Other Publications" cited therein as prior art (e.g., www.monsterboard.com, www.hotjobs.com, www.careermosaic.com, www.futurestep.com). The computer based prior
15 art, however, has functioned simply as electronic analogs of the non-computer art, broadcasting information on current job openings, and accepting resumes from candidates who are actively seeking employment.

For any job opening, however, many potentially excellent candidates may not be actively seeking employment when the job becomes available. Thus, these candidates will not
20 necessarily get the information posted in the employment classified ads or the various internet job sites. Further, because these potentially excellent candidates may not be actively seeking employment, they may not circulate their resumes widely - if at all. Saliently, all of the prior art requires a potential candidate to search job openings (in the newspaper or the internet job sites, for example), write a resume, and then send the resume to a newspaper or internet site for storage
25 in a data base and review. Potential candidates who do not do all of this, do not show up in the prior art resume data bases. Employers thus never get a chance to consider these candidates. This is unfortunate, because the very best candidates often are not currently seeking employment, and thus never get considered.

The claimed invention solves this problem. Rather than forcing a candidate to actively seek employment, the claimed invention can actually search for and find potential candidates, even candidates who are not actively seeking employment, and do not even have a resume prepared at all. That's why Mr. Reuning calls his invention the "Candidate Chaser" - it chases
5 good talent down, rather than waiting for good talent to find it. Thus, in contrast to the prior art, the claimed invention dispenses entirely with the requirement for a written resume, a data structure for uploading resumes, and the user interface required to make resume uploading easy. Unlike the prior art, the claimed invention can work without these structures at all.¹

2. Taylor

10 In the parent '592 case, Taylor was of record. Taylor was expressly found to not enable the Applicant's invention.

Taylor teaches the use of a data base of resumes. Taylor explains, at col. 5, lines 30-35, "The resume base (105) is an electronically stored database. The resume base is a collection of resumes stored in electronically readable memory. The resume records will advantageously
15 include fields specifying name, address, telephone number, E-mail address and narrative fields." Taylor therefore teaches *storage* and retrieval of e-mail address data fields *in a data base*; Taylor does not teach *extraction* of e-mail addresses *from web content*.

On its previous review of Taylor, the Patent Office ruled, "Taylor only performs the comparison of text and *does not suggest any extraction step involving e-mail*. There is no
20 evidence that it would have been obvious to modify Taylor to perform extraction of e-mail addresses." OFFICE ACTION pg. 2, ¶ 3 (03 Jul. 2001) (emphasis added).² The Patent Office

¹ Applicant further explained, "Sabotka discloses searching a resume data structure; Clark discloses a resume data base; and Krellenstein discloses a method for searching a database. Combining these references with Helfman (legally impermissible) makes an improved searchable database. In contrast, the applicant discloses and claims a way of searching the Internet to find potential candidates, without requiring a data base of job openings or resumes at all." AMENDMENT at 6-7 (3 Dec. 2000). The Patent Office agreed with this analysis and withdrew the rejections.

² As an aside, Applicant disagrees with each of the factual assertions set forth in the OFFICE ACTION at page 3, lines 1-5. Specifically, Taylor does not teach a resume base (105) containing web pages. Nothing in Taylor suggests the iterative search engine (106) "can locate web pages from a database of records." Taylor at col. 6, lines 58-60 does not teach presenting e-mail addresses - nor anything else - as hyperlinks; the cited section does not even mention "hyperlink" at all. The cited section does not enable - nor even mention - "Clicking on such a hyperlink pops up an e-mail system which extracts the e-mail address."

concluded that Taylor does not teach - nor even mention - extraction of e-mail addresses from web content, and that Taylor can not anticipate the invention as a matter of law.³

C. Obviousness over "judicial notice"

1. Judicial Notice of this fact is Illegal

5 Claims 2-3 stand rejected as obvious over Taylor "in view of Official Notice."

The OFFICE ACTION acknowledges that Taylor does not teach "relevancy scoring." The OFFICE ACTION, however, takes judicial notice that (i) "relevancy scoring for search results is very well known in the art of database searching," (ii) "It would have been obvious to one of ordinary skill in the art to modify Taylor to include relevancy scoring of results," and (iii)
10 "relevancy scoring of results to reduce the need to review a large number of hits [] is very well known in the art." While the Examiner's three factual assertions might be correct, they are illegal.

Factual assertions (i) and (iii) are illegal, because judicial notice cannot be used to establish what is "very well known in the art." This is because facts concerning the state of the
15 art are "not amenable to the taking of [judicial] notice." In re Eynde, 178 USPQ 470, 474 (C.C.P.A. 1973) ("The facts concerning the state of the art are normally subject to the possibility of rational disagreement among reasonable men and **are not amenable to the taking of [judicial] notice**. If evidence of the knowledge possessed by those skilled in the art is to be properly considered, it must be timely injected into the proceedings"). If evidence regarding
20 skill in the art is to be considered, it must be provided by a reference. Id. Thus, "[a]ssertions of technical facts in areas of esoteric technology **must always be supported** by citation to some reference work recognized as standard in the pertinent art. ... Allegations concerning specific 'knowledge' of the prior art ... should also be supported. ... The facts so noticed . . . **should not** comprise the principle evidence upon which rejection is based." In re Ahlert, 165 USPQ 418,
25 420 (C.C.P.A. 1970).

³ N.b., The Patent Office appears collaterally estopped from disavowing its prior decision regarding Taylor. See In re Lundberg and Zuschlag, 126 USPQ 412, 414 (CCPA 1960) ("patentability over the prior art is not reconsidered as a virgin problem. On the contrary, the prior decision stands, right or wrong, for all disputed issues there decided.").

Likewise, factual assertion (ii) is illegal because a suggestion to combine cannot be based on a judicially-noticed fact. Ex parte Grochowski, No. 95-1343 at 5 (B.P.A.I. June 27, 1995).


Relying on judicial notice of what a skilled artisan would envision - or that a combination would have been obvious - is reversible error. Ex parte Nouel, 158 USPQ 237 (B.P.A.I. 1967).

5 For these rejections to be maintained, Examiner must produce an AFFIDAVIT OF REFERENCES proving each of the three factual assertions.

III. SUMMARY

In light of the amendments and these remarks, withdraw of all rejections is believed required as a matter of law.

10 Respectfully submitted,

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- 5 • It searches thousands of Web sites, newsgroups, bulletin boards and subscription services to locate candidates that match specific job skills, experience and location criteria - rapidly, without your involvement.
- 10 • It uses advanced natural language screening technology to filter out non-relevant information, while uncovering the resumes other search tools miss.
- It automatically sends a personalized message to each candidate, urging them to visit your Web site or reply via e-mail - just like a human recruiter!

15 Id. at http://webhire.com/foremployers/agent_what.htm
(emphasis added).

20 II. A RIGID COMPARISON OF THE ALLEGED
INFRINGING METHOD WITH THE CLAIMS
OF THE APPLICATION HAS BEEN MADE,
AND SOME OF THE APPLICATION CLAIMS
ARE UNQUESTIONABLY INFRINGED

13. I have made a rigid comparison of the Webhire
25 Agent described in the Form 10-K and the internet site, with
the claims of the application.

14. In my opinion, some of the claims are
unquestionably infringed.

15. For example, application claim 20 claims:

- 30 20. A computer implemented method comprising:
- a. locating an Internet site page or web posting which contains operator specified text comprising specifically defined experiences, interests, capabilities, professional titles, talents or the like;
 - 35 b. extracting from said Internet site page or web posting an e-mail address, and
 - c. sending an electronic mail message to said extracted address.